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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,334	11/18/1999	KARI VIRTANEN	PM264014	3837

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EXAMINER

IQBAL, KHAWAR

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 06/03/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/381,334

Applicant(s)

VIRTANEN, KARI

Examiner

Khawar Iqbal

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being unpatentable by Josse et al (6104929).

Regarding claim 1 Josse et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises a home location register for maintaining subscriber data and supports a first network, and a second network, the method comprising: (abstract, figs. 1-5):

maintaining the mobile subscriber data in the home location register, and sending, from another network element, a message to the home location register for requesting the mobile subscriber data (col.7, lines 23-47, col.6, line 25-col. 7 line 30),

the home location register maintaining an access parameter which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 8, lines 6-20, col. 6, lines 25-65);

in response to said message for requesting the subscriber data, the home location register sending the mobile subscriber data and also said access parameter (col.7, lines 23-45, col. 8, line 60-col.9, line 10);

the network element that requested the mobile subscriber data using said access parameter for restricting the access of the mobile subscriber only to the first network or to the second network (col.8, lines 6-20, col. 6, lines 49-67,col. 14, lines 25-50).

Regarding claim 2 Josse et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises home location register for maintaining subscriber data and supports a first network, and a second network, (abstract, fig. 1-5):

the method comprising

storing mobile subscriber data in the memory of a mobile station, mobile subscriber data and an access parameter indicating whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 10, lines 45-65, col. 6, lines 15-67); and

the mobile station using said access parameter to restrict the access of the mobile subscriber only to the first and/or the second network (col. 6, lines 49-67, col. 8, lines 6-20, col. 7, lines 20-30).

Regarding claim 3 Josse et al teaches the mobile subscriber's access can be restricted only to one network even though a short message service had been defined for the mobile subscriber (col. 15, lines 45-50,col. 16, lines 60-65).

Regarding claims 4-6 Josse et al teach wherein the network element that requested the mobile subscriber data uses said access parameter to prevent location updating in a network which the mobile subscriber is not entitled to use (col. 6, lines 15-35, col. 7, lines 22-60).

Regarding claims 7,11 and 13 Josse et al teach first network is a circuit-switch and second is packet-switched (col.6, lines 50-65, col. 11, lines 11-35).

Regarding claims 8-10 and 12 Josse et al teaches a data structure which comprises (abstract, figs. 1-5)

mobile subscriber data in a telecommunications system which supports a first and a second network (col.8, 6-15);

an access parameter which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col.6, line 49-col. 7, line 30, col. 8, lines 6-20).

### ***Response to Arguments***

3. Applicant's arguments filed 03-21-2003 have been fully considered but they are not persuasive. The examiner has thoroughly reviewed applications argument but firmly believes the cited references to reasonably and properly meets the claim limitation. Applicant argument was that the "Josse fails to disclose or suggest a method or data structure that include an access parameter indicating whether the mobile subscriber is

entitled to use the first network, the second network or both networks. As recited in claims 1,2 and 8. In response to applicant' arguments, examiner would like to point out that the class parameter define whether the mobile subscriber is to use the first network (circuit switched), the second network (packet switched) or both. An IMSI-attached class-A mobile station engaged in a circuit switched connection does not indicate that it is IMSI-attached when it performs a GPRS attach. In the attach function, the MS provides its IMSI and an indication of which type of attach that is to be executed. The different types of attach are IMSI attach, GPRS attach, and combined IMSI/GPRS attach (col. 6, lines 25-65). An IMSI-attached class-C mobile station follows the normal IMSI detach procedure before it makes a GPRS attach. A GPRS-attached class-C mobile station performs a GPRS detach before it makes an IMSI Attach. The SGSN address for this particular mobile station's location is stored in the HLR so that changes in subscriber data can be communicated to the SGSN. If new subscriber data is received in the SGSN, and if the mobile station is GPRS-attached, the SGSN may, if required, command the mobile station to make a new GPRS attach and new PDP context activations so that the new subscriber data is taken into use (col. 7, lines 5-15). The "Attach Type" parameter indicates which type of attach is to be performed, i.e., GPRS Attach only, IMSI Attach only, or a combined GPRS and IMSI Attach. A combined GPRS and IMSI attach is used also in the case of a GPRS Attach when the MS is already IMSI-attached (col. 8, lines 10-15). Josse et al teach, "If PLMN-Supported MT Capabilities indicates that only GPRS MS Class-C mode of operation is supported, i.e., the Gs interface is not installed, than a Class-A or B mobile station shall either: (1)

perform an explicit IMSI detach via the non-GPRS control channels (if the MS was already IMSI-attached); or (2) access the non-GPRS control channels for circuit switched (CS) operation (the way that circuit switched operation is performed in parallel with GPRS operation is a MS implementation issue outside the scope of this specification); or (3) avoid all circuit switched signaling. If the PLMN-Supported MT-Capabilities parameter indicates that also GPRS MS Class A and B mode of operation is supported, and the mobile station used to be communicating with a SGSN that only supports Class-C mode of operation, then a Class-A or B mobile station that needs to perform IMSI attach and Location Updates shall do this via the SGSN. Moreover, if that Class-A or B mobile station is already IMSI-attached, it immediately performs a Location Update via the SGSN to allow the VLR to store the SGSN address" (col. 14, lines 5-55). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the examiner has given the claim language its broadest reasonable interpretation. Since applicants have not argued any dependent claims, they stand or fall with the independent claims. Claim 14 has been canceled.

### Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is 703-306-3015.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **DWAYNE BOST**, can be reached at 703-305-4778.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to: (703) 872-9314 (for Technology Center 2684 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Khawar Iqbal

*Chau*  
5-5-03

*Lee Nguyen*  
Lee Nguyen  
Primary Examiner